UNITED STATES PATENT AND TRADEMARK OFFICE

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09/782,107	02/13/2001	Mihal Lazaridis	555255012189	3129

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *01 May 2008*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *90-95,97-102 and 105-108* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *90-95,97-102 and 105-108* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1.　　Applicant has failed to adequately traverse the double patenting rejection originally set forth in the Office action of 7/3/2007. Accordingly, the double patenting rejection is <u>maintained</u>. Since the amended claims contain similar subject matter to those previously rejected, the rationale set forth in the Office action of 7/3/2007 remains applicable and will not be repeated here.

2.　　Claims 90, 99 and 105 (as currently amended) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 65, 97 and 108 of copending Application No. 09/782,412. This is a <u>provisional</u> obviousness-type double patenting rejection. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications contain the principal feature of common addressing.

　　Claims 90, 99 and 105 of the present application additionally include encryption of the mail items prior to delivery. Encryption is also old and well known in the art. Claims 65, 97 and 108 of copending Application No. 09/782,412 additionally include piecemeal delivery of messages, which is known in the art and taught by Eggleston (e.g., col. 3, ll. 23-34; col. 10, l. 10 to col. 11, l. 4).

　　Since both claim sets claim substantially the same invention, and the differences between them are old and well known, the claims are not patentably distinct and are rejected on the ground of nonstatutory obviousness-type double patenting.

Response to Arguments

3.   Applicant's amendments to claims 99-102 and 104 are sufficient to overcome the rejection of those claims under 35 U.S.C. § 101. That rejection has been withdrawn.

4.   Applicant's arguments, see pp. 16-25, filed 5/1/08, with respect to the rejection(s) of claim(s) 90-95, 97-102 and 105-108 under 35 U.S.C. § 103 have been fully considered and are persuasive. The Examiner agrees that the Airmobile reference fails to disclose a first address associated with a messaging host system and a second message associated with a user device, wherein a message directed to the first address is redirected to the second address, and a subsequent response contains the first address as the response's originating address. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tello et al. (US 6,381,634).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 90-95, 97-102 and 105-108 are rejected under 35 U.S.C. 103(a) as being

unpatentable over AirMobile Server (AirMobile Wireless Software for Lotus cc:Mail,

Communication Server Guide, Motorola, 1995), in view of AirMobile Client (AirMobile

Wireless Software for Lotus cc:Mail, Communication Client Guide, Motorola, 1995), and

Carthy et al. (MAPI Developers Forum post "MAPI Notification" April 12, 1996) further in

view of Eggleston et al. (US 5,764,899) further in view of Murota (US 6,289,105) further

in view of Tello et al. (US 6,381,634).

        Note, the AirMobile Server and AirMobile Client guide present different aspects

of the same system, and are therefore are treated as a single system for the purposes

of this rejection. They are hereinafter referred to with specific citations to the Server

guide as "AirMobileS" and the Client guide as "AirMobile."

7.   With regard to claim 90, AirMobile disclosed a method of redirectinginformation

between a messaging host system ("communication server") and a wireless mobile data

device that is associated with a computer (i.e. the mobile device in AirMobile is in and of

itself a computer) connected over a network to the messaging host system (p. 9,

"Communication Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is

received and stored at the communication server, and the mail account is associated

with a mobile device according the device ID), the method comprising:

      ❑   receiving a notification at a redirector component indicating receipt of a mail

           item for a user by the messaging host system, wherein the user data item is

           addressed to a first mail address of the user that is associated with the

messaging host system and is viewable via the computer (e.g. Airmobile

pushes received messages to the mobile clients and this push algorithm is

invoked by some internal notification; see inter alia pgs 30 and 31 "enables

messages to be immediately downloaded when they are received"];

❏ sending the mail item from the redirector component to the wireless mobile

data device over a wireless network (the actual push or download of the

message to the mobile device pg 31, ¶s 1-3).

❏ receiving a reply mail item from the wireless mobile data device at the

redirector component (e.g. sending reply to the server pg 38);

❏ interfacing the reply mail item to the messaging host system by the redirector

component such that the reply mail item is sent to the sender (e.g. forwarding

the reply to the original sender, pg 38).

While AirMobile discloses substantial potions of the claimed invention (discussed

above), it fails to specifically recite 1) that the *notification* is *automatically generated* in

response to receipt of the user data item, 2) transmitting a *copy* of the received

electronic message, 3) using encryption for sending messages between the redirector

component and the mobile data device, or 4) that the mail item is redirected to a second

address associated with the user and the reply message's originating address is

configured to be the first address.

8.   With regard to point (1), AirMobile failed to specifically recite that the *notification*

is *automatically generated* in response to receipt of the user data item. AirMobile

disclosed a server side push technology (pg 31 ¶ 1-3), where the server must internally

poll for the arrival on new messages in a user's mailbox. Nonetheless Examiner

maintains that such an automatic notification must occur in the system in order for the

actual forwarding software to be invoked within the computer system. Furthermore

even if one were to argue persuasively that such a notification is not inherent then

Examiner maintains that adding a new data item automatic notification feature would

have been an obvious modification to AirMobile at the time of Applicant's invention, in

view of at least Carthy.   In a similar art, Carthy disclosed an e-mail system where the

notification of new messages in a user's mailbox is sent **automatically,** as opposed to

polling, using an extended MAPI IMAPIadviseSink notification (See the Carthy post

describing "full asynchronous" notification in extended MAPI). Carthy further disclosed

that in order to receive these automatic notifications the system must register with a

software interface associated with the messaging server (i.e. registering with the

ImsgStore to receive adviseSinks). Cathy also disclosed that automatic notification is

preferable to polling (see the Cohen post below: "Today I do a polling on each mailbox :

I open a connection through MAPI functions, I consult, I notify if new mail, and I close

the connection. Then I go to the next mailbox and do the same actions. It's not great :(.

So I'd like to know whether –there- exists another way to notify with MAPI, especially a

"fully asynchronous" notification").   Automatic notification is preferable to polling for

detecting the arrival of new messages since the detection process is more efficient. For

example the system no longer has the delay associated with polling each user's mailbox

and is instead alerted immediately of the arrival of new messages. Additionally less

system resources are consumed since the system no longer has to poll the mailbox of

each user in order to detect new messages.

Thus, it would have been obvious to one of ordinary skill in the art at the time of

the invention to incorporate the automatic notification functionally disclosed by Carthy

within AirMobile's system, since Carthy disclosed automatic notification is preferable to

polling and further since the use of automatic notification is more efficient. Again

automatic notification is more efficient since the system is alerted immediately of the

arrival of new messages and less system resources are consumed.

9.   With regard to point (2), AirMobile discloses forwarding messages received at the

messaging server to the wireless device. However, AirMobile does not *explicitly* state

that the messages forwarded to the wireless mail system are a *copy*. Nonetheless,

most e-mail systems that forward messages actually replicate the messages before

forwarding, so that a copy of the message is retained in the initial destination mailbox.

Such replication is disclosed by Eggleston. In a similar art, Eggleston teaches a system

for forwarding messages from a LAN-based host through a wireless host to a mobile

client device, wherein the LAN-based host stores messages, thereby maintaining a

replica of the messages, before forwarding them to the client (col. 4, lines 44-51; col.

12, lines 32-39, 59-62, wherein the messages are copied and maintained at a host

system, and are also sent to target units).

Thus, given the teaching of Eggleston, a person having ordinary skill in the art would have readily recognized the desirability and advantages of replicating the messages at the messaging server taught by AirMobile, to preserve received messages in case the client memory fails or the message is lost in transmission. Therefore, it would have been obvious to include the mail replication feature taught by Eggleston in the mail forwarding system taught by AirMobile and Carthy.

10.   With regard to point (3), AirMobileS disclosed sending messages from the cc:Mail server to the mobile device in a secure fashion (AirMobileS, p. 25, bullet 1 "secure and authenticated virtual wireless communication channel between your laptop and your LAN-based cc:Mail server") however, AirMobile does not disclose using encryption for sending messages in a secure fashion. Nonetheless the use of encryption to send messages securely was widely known in the art at the time of Applicant's invention, as evidenced by at least Murota. In a similar email system, Murota disclosed encrypting e-mail messages between a sender and a receiver, wherein a message is encrypted at the sending end, is then transmitted over the network to the receiving end, and is finally decrypted at the receiving computer (col. 1, lines 23-48). Murota further disclosed that such an encryption scheme is advantageous because it prevents leaks of secret information to outside, non-intended parties (Murota, col. 1, lines 49-53).

Thus, given the teaching of Murota, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention include an encryption function,

as taught by Murota, in conjunction with the redirector component of AirMobile such that

messages sent between the AirMobile server and mobile devices are encrypted, in

order to prevent outside parties from having access to secret or classified messages.

11.   With regard to point (4), Tello discloses a similar system for forwarding e-mail

messages from a host system associated with a first e-mail address to a second system

associated with a second e-mail address. Tello teaches receiving an e-mail message at

a host machine (ISP mail server) associated with a first e-mail address (well-known-

name value 505)(col. 4, ll. 43-48; col. 5, ll. 29-33), and redirecting the message to a

second address associated with the recipient (well-known-name-value is converted into

literal address for redirection)(col. 5, ll. 33-39). Tello further discloses that the user's

well-known name address remains unchanged, even if the literal address associated

with it changes (col. 5, ll. 56-67), permitting e-mail address portability (col. 5, ll. 58-60).

The combined teachings of AirMobile and Tello would have taught and/or suggested

using the first address (the well-known name value) as the return address in any reply

messages, since it would have maintained the portability of the address, permitting later

communications in response to the reply message to reach the user via the SCP

system, even if the user's literal address changed in the meantime.

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to permit forwarding of messages to a second address

associated with the user, and use the first address as the originating address of any

subsequent reply messages, to maintain portability of the user's e-mail address and

ensure that additional messages in the conversation are sent to the user's current

location.

12.   With regard to claim 91, AirMobile disclosed the redirector component is

operating on the messaging host system (pg 9 "communication server" and pg 31 ¶s 1-

3).

13.   With regard to claim 92, AirMobile disclosed the redirector component is

operating on a host system that is couple to the message host system via the network

(e.g. the Network fiel server cc:Mail Postoffice works in tandem with the Windows

AirMobile server pg 9).

14.   With regard to claim 93, Eggleston disclosed that messages sent between the

wired and wireless systems can be compressed (col. 11, lines 63-67). Given this

knowledge, it would have been obvious to a person having ordinary skill in the art to

compress the messages in the system taught by AirMobile, Carthy, Bezaire, and

Eggleston, prior to transmission to the gateway, and to decompress the messages at

the mobile device, as suggested by Eggleston, in order to increase available bandwidth

and to provide faster and less expensive communications (see Eggleston, col. 12, lines

7-9).

15.   With regard to claim 94, AirMobile disclosed the processing step further

comprises encoding the copy of the user data item (e.g. transforming a message into

the required transmission protocol for the wireless network being utilizing prior to

pushing a message to the user) (additionally compressing as set forth with regard to

claim 106 is a form of encoding).

16.   With regard to claim 95, Examiner takes official notice that the Multipurpose

Internet Mail Extensions protocol was widely known and used to communicate email

messages between devices at the time of Applicant's invention. Thus, it would have

been obvious to one of ordinary skill in the art at the time of Applicant's invention to

encode messages using the MIME protocol within AirMobile's system in order to

communicate messages between devices using a known reliable protocol.

17.   With regard to claim 97, AirMobile disclosed the step of sending the copy of the

user data item from the redirector component to the wireless mobile data device over

the wireless network further comprises sending the copy of the user data item via a

wireless gateway disposed between a wide area network and the wireless network (see

pg 9, Figure 1-1, a gateway is required to interface between the networks).

18.   With regard to claim 98, AirMobile disclosed the step of storing the user data item

at the data store associated with the messaging host system (p. 9, "Communication

Server," p. 10, "User Profile Database," pp. 15-16, wherein mail is received and stored

at the communication server, and the mail account is associated with a mobile device according the device ID).

19.   Claims 99-102 and 105-108 are rejected under the same rationale as claims 90-95, 97 and 98, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Conclusion

20.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenton B. Burgess/
Supervisory Patent Examiner, Art Unit 2153

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